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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,203	03/28/2001	Padmapriya Banada Padmanabha	U 013352-8	3844

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12/04/2002

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EXAMINER

SAKELARIS, SALLY A

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 12/04/2002

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,203

Applicant(s)

PADMANABHA ET AL.

Examiner

Sally A Sakelarlis

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Application may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) g.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicants' election of Group I(Claim 1) in paper no. 12, filed 10/03/2002, is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, but instead elected without traverse, no response to applicant arguments is required MPEP § 818.03(a)).

Claim Objections

2. Claim 1 is objected to because the assigned SEQ ID NOs have not been used to identify each sequence listed, as required under 37 CFR §1.821(d). The claim should be amended to include SEQ ID NO: 1 and SEQ ID NO: 2 adjacent to the corresponding primer sequence.
3. Claim 1 is further objected to because of the following informalities:
In claim 1, a “.” should be inserted following the “SEQ ID NO:2.” That should be added to rectify the objection as described in number 2 above.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claim 1 is still further indefinite with regards to the recitation of "oligonucleotide primer." It is unclear if applicant is referring to only one of the two primers listed, or if the applicant intended to include "primers" instead of "primer." Applicant should amend the claims to clarify if they are intending to claim both primers (SEQ ID NO: 1 and SEQ ID NO:2) or just one of the primers.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kuppe et al. (J. Bacteriology, 1993)

Kuppe et al. teach an oligonucleotide primer for phosphatidyl inositol in *B. cereus* comprising "PI-2" listed second in claim one (see attached alignment, result 3)

It is noted that claim 1 recites the open claim language "comprising" therefore including oligonucleotides that have sequences flanking SEQ ID NO:2. Furthermore, it is noted that it is a property of the oligonucleotide of Kuppe that it is a primer since the oligonucleotide can be extended at its 3' end.

6. Claim 1 is also rejected under 35 U.S.C. 102(b) as being anticipated by Myers, R.M. (STS 04-Jan-1996).

Myers et al. teach an oligonucleotide primer comprising the sequence listed as "PI-1" in claim one (see attached alignment, result 1).

Furthermore, as stated in MPEP 211.02, "When the claim is directed to a product, the preamble is generally non-limiting if the body of the claim is directed to an old composition and the preamble merely recites a property in the old composition. *Kropa v. Robie*, 187 F.2d at 152, 88 USPQ at 480-481". The MPEP (2112) further states that the "claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable". Accordingly, the identification of a new use (i.e. primer for phosphatidyl inositol in *B. cereus*) for the known primer sequence, does not render the primer sequence novel.

It should be noted that these 102(b) rejections are being made in light of the indefinite wording cited in the 112 2nd paragraph rejection, with respect to "primer" and the resulting need for only one "primer" as the claim is presently written.

It is further noted that claim 1 recites the open claim language "comprising" therefore including oligonucleotides that have sequences flanking SEQ ID NO:1. Furthermore, it is noted that it is a property of the oligonucleotide of Myers et al. that it is a primer since the oligonucleotide can be extended at its 3' end.

Conclusion

7. No claims are allowable over the prior art

Prior Art

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The closest prior art of Accession Number M30809, BCT 26-APR-1993, is revealed as applicant as the source of the primers of claim 1. It should be noted that "PI-1" of claim one, is not found anywhere within this submitted, GenBank sequence.

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Please see attached GenBank print-out, Nucleotides 1063-1077 ending in "...GAC" not "...GAG" as claimed.

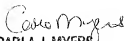
Any inquiry concerning this communication or earlier communication from the examiner should be directed to Sally Sakelarlis whose telephone number is (703) 306-0284. The examiner can normally be reached on Monday-Friday from 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W.Gary Jones, can be reached on (703)308-1152. The fax number for the Technology Center is (703)305-3014 or (703)305-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to Chantae Dessau whose telephone number is (703)605-1237.

Sally Sakelarlis


11/26/02


CARLA J. MYERS
PRIMARY EXAMINER